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No. 07-1537

IN THE

Supreme Court of the United States

STRYKER CORPORATION,

Petitioner,

v.

TRIMED, INCORPORATED,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF

GREGORY J. VOGLER
Counsel of Record
ROBERT A. SURRETTE
MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street
Suite 3400
Chicago, IL 60661
(312) 775-8000

Attorneys for Petitioner

217097

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

RULE 14.1(b) AND 29.6 STATEMENT

Petitioner's corporate disclosure statement was set forth at page *ii* of its Petition for a Writ of Certiorari, and there are no amendments to that statement.

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This Petition For A Writ Of Certiorari ("Petition") addresses two critical areas of patent law where the Federal Circuit has allowed a patent applicant to broaden impermissibly the scope of his or her patent monopoly. First, and foremost, this Petition raises issues regarding the proper statutory construction of 35 U.S.C. § 112, ¶ 6. As enacted, this statutory provision embodied safeguards to be employed when a patent applicant chose to express his or her invention in "means for performing a specified function" language. The Federal Circuit's erosion of these safeguards through its judicially-created exception to the clear statutory language has led to an analytical framework at odds with the statutory text and unable to produce predictable or consistent results. Tellingly, Respondent does not dispute that the current landscape often produces such arbitrary results. Second, this Petition raises issues regarding the Federal Circuit's recent willingness to diminish the public notice function served by a patent's prosecution history by disregarding a patent applicant's concession concerning a patent claim feature in a bargained-for-agreement with the United States Patent and Trademark Office ("Patent Office"). Review by this Court is needed to ensure that the Patent Office, patent applicants and the public can ascertain predictably the proper scope of any given patent monopoly.

I. RESPONDENT'S ARGUMENT REGARDING THE INTERPRETATION OF 35 U.S.C. § 112, ¶ 6 HIGHLIGHTS THE SIGNIFICANT PROBLEMS CAUSED BY THE FEDERAL CIRCUIT'S ERRONEOUS STATUTORY CONSTRUCTION

In attempt to persuade this Court that its guidance is not necessary, TriMed, Incorporated ("Respondent") ignores years of Federal Circuit law and the clear text of 35 U.S.C. § 112, ¶ 6. According to Respondent, "if the claim recites structure, with or without the word 'means,' that element is not a means-plus-function element under 35 U.S.C. § 112, ¶ 6. This clear reading of the statute has been the established law." Opp'n at 9. As illustrated below, both Respondent's belief regarding the proper interpretation of § 112, ¶ 6, and Respondent's characterization of the Federal Circuit's law simply are wrong. Direction from this Court regarding the proper statutory construction of § 112, ¶ 6 will restore the safeguards that Congress intended to be in place for all "means for performing a specified function" claim elements.

A. An Important Question Of Statutory Construction Will Go Unresolved Unless This Court Grants Petitioner's Writ Of Certiorari

Stryker Corporation's ("Petitioner") Petition highlights the problematic nature of the Federal Circuit's erroneous construction of 35 U.S.C. § 112, ¶ 6. Consequently, in order to justify the current legal landscape, Respondent is forced to advance an argument that is at odds with the statutory language and that produces unworkable results. According to

Respondent, the inclusion of the statutory language "without the recital of structure, material, or acts in support thereof" means that any recital of structure in a claim element removes that element from the ambit of § 112, ¶ 6. *See, e.g.*, Opp'n at 9. Respondent's argument for denial of the instant Petition, however, suffers from two fundamental flaws.

First, Congress enacted 35 U.S.C. § 112, ¶ 6 to cure a specific problem. *See Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 28 (1997). Because this Court previously determined that functional or "means" claim elements were too indefinite, Congress enacted § 112, ¶ 6 to sanction the use of "means for performing a specified function" claim elements so long as those elements were construed according to the terms of the statute. *See Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 10-12 (1946); 35 U.S.C. § 112, ¶ 6. In particular, the statute made clear that a patent applicant was permitted to define his or her invention in solely functional language—*i.e.*, "without the recital of structure." 35 U.S.C. § 112, ¶ 6. The statute, contrary to Respondent's assertions however, does not prohibit reciting structural language in combination with functional language. In other words, the statute allows an applicant to define a claim element with functional language. When the applicant chooses to do so, it is in the applicant's discretion whether or not to recite structure. In either situation, the claim element is still subjected to the statutory mandate that it "**shall be construed** to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." *Id.* (emphasis added).

Second, Respondent's Opposition illustrates the unworkable nature of Respondent's proposed construction. Throughout its Opposition, Respondent continually flip-flops regarding what it believes to be the proper scope of § 112, ¶ 6. For example, Respondent repeatedly argues that "[t]he statute clearly states that § 112, ¶ 6 is invoked when structure is not recited in a claim." Opp'n at 1. Respondent's argument does not solve other very real problems. For example, how is a court to interpret claims that recite structure but not enough structure to perform all the claimed functions (as is the case here)? In that situation, the applicability of the judicially-created exception to § 112, ¶ 6, even under Federal Circuit decisions, becomes uncertain. This once again creates the problems addressed by this Court in *Halliburton* whereby functional claims become overbroad and ambiguous because the claim language does not delineate the true scope of the invention. *Halliburton*, 329 U.S. at 12. On the other hand, contrary to the construction adopted by the Federal Circuit and Respondent, Petitioner's proposed construction to construe all claim elements written in "means for performing a specified function" format solves the *Halliburton* problem in all instances because it ensures that all such claim elements are interpreted in accordance with the statutory safeguards of § 112, ¶ 6.

Apparently recognizing these problems, Respondent reverses course and simultaneously repeatedly argues that "Title 35 U.S.C. § 112, ¶ 6 expressly requires the lack of structure, i.e., 'means,' to perform the claimed function. If the element recites the **precise structure** that performs the claimed function, § 112, ¶ 6 does not apply." Opp'n at 10 (emphasis added.) The statute,

however, does not say "without the recital of the **precise structure** that performs the claimed function." *See* 35 U.S.C. § 112, ¶ 6. Therefore, to get around the significant problems caused by its own advocated statutory construction, Respondent has to insert words into the statutory language.[1]

Respondent's flip-flopping between two different statutory constructions highlights that the only workable reading of the clear language of § 112, ¶ 6 is that a claim element using the words "means for," plus the recital of function(s) to be performed, shall be interpreted in accordance with § 112, ¶ 6 in all circumstances. *See, e.g.*, Kimberly A. Moore, Markman *Eight Years Later: Is Claim Construction More Predictable?*, 9 Lewis & Clark L. Rev. 231, 243 (2005); William F. Lee & Eugene M. Paige, 80 J. Pat. & Trademark Off. Soc'y 251, 266 n.106 (1998). Such a construction will eliminate the unpredictable and arbitrary results caused by the Federal Circuit's current analytic framework and provide a consistent interpretation for all "means for" claims, without any loopholes, in all circumstances. This Court's guidance is therefore needed to eliminate the uncertainty produced by the Federal Circuit's judicially-created exception to 35 U.S.C. § 112, ¶ 6.

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1. Despite the use of the phrase "precise structure," Respondent's construction is essentially identical to the Federal Circuit's "sufficient structure" language. Under either approach, some claims with structure will be interpreted under the statute and in other instances claims with structure will not be interpreted under the statute, thus generating inconsistent, unpredictable and arbitrary results.

B. Respondent Ignores The Arbitrary And Capricious Results Obtained Under The Federal Circuit's Jurisprudence

Not only does Respondent misunderstand the statutory language of 35 U.S.C. § 112, ¶ 6, but additionally, Respondent over-simplifies Federal Circuit law in a further attempt to justify the existing analytical framework.

For years the Federal Circuit has erroneously construed § 112, ¶ 6. Rather than interpret all "means for performing a specified function" claim elements in accordance with the statute, the Federal Circuit has created a judicial loophole whereby if the Federal Circuit determines that a claim element recites "sufficient structure," it is removed from the ambit of § 112, ¶ 6. *See, e.g., Biomedino, LLC v. Water Techs. Corp.*, 490 F.3d 946, 950 (Fed. Cir. 2007); Petition at 3-4, 14, 19-20. This judicially-created exception for patent owners dissatisfied with the scope of their issued claims, has led to countless unpredictable and arbitrary rulings regarding the scope of claim elements written in "means for performing a specified function" format. *See* Kimberly A. Moore, 9 Lewis & Clark at 242-43; *cf.* William F. Lee & Eugene M. Paige, 80 J. Pat. & Trademark Off. Soc'y at 266-68; Petition at 15-16, 19-23. The unnecessary uncertainty created by this judicial loophole illustrates that now is an appropriate time for this Court to address the proper construction of § 112, ¶ 6.

Tellingly, Respondent fails to address or dispute that the current legal landscape abounds with uncertainty. Instead, apparently knowing that the existing analytical framework is unworkable, Respondent, in order to

rationalize the Federal Circuit's statutory construction, grossly mischaracterizes years of Federal Circuit law. Specifically, Respondent argues that under "established law" "if the claim recites structure . . . that element is not a means-plus-function element under 35 U.S.C. § 112, ¶ 6." Opp'n at 9. As previously illustrated by Petitioner, however, Respondent's statement that the recital of any structure in a "means for performing a specified function" claim element precludes the application of § 112, ¶ 6 is belied by the case law. *See supra*; *see also* Petition at 3-4, 14, 19-20. Indeed, even the cases cited by Respondent in support of its erroneous simplification of the Federal Circuit's law, state that § 112, ¶ 6 applies unless there is the recital of "sufficient structure" or "definite structure." *See* Opp'n at 9.[2]

Ultimately, Respondent's decision to ignore years of Federal Circuit law fatally undermines its argument that this Court need not address the statutory construction issues presented by Petitioner's case. In fact, it is the Federal Circuit's insertion of the judicially-created "sufficient structure" exception into the clear language of § 112, ¶ 6 that has resulted in the unpredictable, arbitrary and capricious claim construction rulings discussed in this Petition. Petition

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2. *See also Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1304 (Fed. Cir. 2005) (claim element was "sufficiently structural"); *TI Group Automotive Sys., Inc. v. VDO N. Am., L.L.C.*, 375 F.3d 1126, 1135 (Fed. Cir. 2004) ("definite structure"); *Envirco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 1364 (Fed. Cir. 2000) (presumptive application of § 112, ¶ 6 does not apply if claim element recites "sufficient structure"); *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531 (Fed. Cir. 1996) ("definite structure").

at 19-20. Moreover, these unpredictable and arbitrary rulings resulting from the current analytical framework are typified by this case. In particular, here not only did Robert Medoff, the patent applicant, ("Applicant") and the Patent Office explicitly agreed to write the claim element at issue in means-plus-function format, but moreover, the Applicant then amended the claim element to include "means for performing the specified function" language. Supp. App. at SA-7-SA-11. It could not be any clearer that when the patent issued, both the Applicant and the Patent Office intended for the last element of claim 1 to be interpreted as a means-plus-function element under § 112, ¶ 6. Year later, however, the Federal Circuit was able to broaden impermissibly the scope of Respondent's patent by invoking its judicially-created loophole to the statutory mandate of § 112, ¶ 6.

The uncertainty that the Federal Circuit's judicially-created exception produces is the precise reason that Petitioner has sought this Court's guidance. At no point does Respondent dispute that in the current legal landscape, inconsistent rulings regarding the proper interpretation of means-plus-function elements abound. *See* Petition at 19-20. The arbitrary results generated by the Federal Circuit's judicially-created exception to the clear language of § 112, ¶ 6 illustrate that the instant Petition raises important issues of statutory construction that are appropriate for this Court to address.

II. THIS CASE IS A PROPER VEHICLE FOR THIS COURT TO ADDRESS THE SIGNIFICANCE OF A PATENT'S PROSECUTION HISTORY

Respondent does not dispute that "the record before the Patent and Trademark Office is often of critical significance in determining the meaning of the claims." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Nor does Respondent dispute that a patent applicant should be bound by any agreement struck with the Patent Office in order to secure allowance of the patent. *See, e.g., Schoenhaus v. Genesco, Inc.*, 440 F.3d 1354, 1359 (Fed. Cir. 2006); *Spring Window Fashions LP v. Novo Indus. L.P.*, 323 F.3d 989, 995 (Fed. Cir. 2003). Rather, Respondent tries to escape the fact that these fundamental principles were ignored in this case by unilaterally and after-the-fact attempting to change the terms of the Applicant's bargained-for-agreement.

A patent's prosecution history is meant to inform the public of any agreements or statements that were made regarding the scope of the patent's claims. *See Spring Windows*, 323 F.3d at 995. In this case, the prosecution history refers to an agreement between the Applicant and the Patent Office which explicitly states that the last element of claim 1 was to be written in "means-plus-function" format. Supp. App. at SA-7. Even though the Applicant amended the claim element "[i]n accordance with the determinations made at [the] interview," and even though the Applicant recited the element at issue with "means for" language followed by the recitation of function (classic means-plus-function format), Respondent now argues that the Applicant

allegedly chose to write the claim element in such a way that it surpassed any requirements of his agreement with the Patent Office. *Id.* at SA-9-SA-11; Opp'n at 14-16. The problem with Respondent's after-the-fact argument is that (1) the Applicant should have told the Patent Office back then that he was allegedly changing the bargained-for-agreement, and (2) he should not have used the agreed-to means-plus-function language. Respondent's arguments are not credible.

Even if Respondent's arguments were believed, at best Respondent has created an ambiguous record regarding the scope of the last element of claim 1. Specifically, upon reading the prosecution history, a member of the public would be left with the logical conclusion that the claim element at issue was written in means-plus-function format. After all, the Applicant agreed to do so, said he was doing so, and ultimately utilized classic means-plus-function format when amending his claim. Supp. App. at SA7-SA-11. Nowhere in the prosecution history did the Applicant expressly disavow his agreement with the Patent Office. Therefore, Respondent's argument advanced years after the patent issued that the insertion of the word "holes" in the claim element somehow altered the terms of the agreement at worst is a disingenuous and at best creates an ambiguity.

Assuming that the Applicant created an ambiguity in the prosecution history regarding his bargained-for-agreement, the Federal Circuit should have interpreted the ambiguity against Respondent. Specifically, in the interpretation of other legal instruments, to the extent ambiguities exist, they are interpreted against the

drafter. *See Mastrobuono v. Shearson Lehman Hutton, Inc.*, 514 U.S. 52, 62-63 (1995) ("[R]espondents cannot overcome the common-law rule of contract interpretation that a court should construe ambiguous language against the interest of the party that drafted it."); Restatements (Second) of Contracts § 206 (1981) ("In choosing among the reasonable meanings of a promise or agreement or a term thereof, that meaning is generally preferred which operates against the party who supplies the words or from whom a writing otherwise proceeds."). This rule of construction is eminently practical because

> [w]here one party chooses the terms of a contract, he is likely to provide more carefully for the protection of his own interests than for those of the other party. He is also more likely than the other party to have reason to know of uncertainties of meaning. Indeed, he may leave meaning deliberately obscure, intending to decide at a later date what meaning to assert. In cases of doubt, therefore, so long as other factors are not decisive, there is substantial reason for preferring the meaning of the other party.

Restatements (Second) of Contracts § 206 cmt. a; *see also Mastrobuono*, 514 U.S. at 63 n.10.

This case presents an excellent vehicle for this Court to consider the role of a patent's prosecution history generally, and more specifically to clarify that a patent and its prosecution history should be interpreted no differently than any other legal instrument. Here, as discussed above Respondent attempts to introduce an ambiguity into the prosecution history by arguing that the Applicant's claim amendment somehow trumped or altered the terms of the Applicant's bargained-for-agreement. But, only the Applicant "[had] reason to know of [the] uncertainties of [the] meaning" of his amendment. Restatements (Second) of Contracts § 206 cmt. a. Indeed, perhaps the Applicant and Respondent "[left] meaning deliberately obscure, intending to decide at a later date what meaning to assert." *Id.* Such tactics, however, thwart the public notice function served by the prosecution history, for there was no way for the public to know of the Applicant's apparent intention to violate his bargained-for-agreement. Thus, because a patent is no different from other legal instruments, in situations where the patent applicant attempts to muddy the prosecution history with ambiguous statements, those statements should be interpreted against the applicant.

For the above reasons, this Court's guidance is needed to clarify the role of a patent's prosecution history so that it can continue to be a valuable resource to the public regarding the scope of a patent's monopoly. Without such clarity, the public will no longer be able to rely on explicit statements in a patent's prosecution history when trying to determine what technologies remain in the public domain.

CONCLUSION

To restore the statutory safeguards of 35 U.S.C. § 112, ¶ 6 enacted by Congress and eroded by the Federal Circuit, and to restore the vital public notice function of a patent's prosecution history, the petition for a writ of certiorari should be granted.

Respectfully submitted,

GREGORY J. VOGLER
Counsel of Record
ROBERT A. SURRETTE
MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street
Suite 3400
Chicago, IL 60661
(312) 775-8000

Attorneys for Petitioner